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CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)

Applicant(s): Curtis et al.

Docket No.

RSW920010035US1

Application No.

09/810,629

Filing Date

3/16/2001

Examiner

Reagan, James A.

Group Art Unit

3621

Invention: **IMPROVED METHOD FOR REPORTING CHARACTERISTICS OF A SERVICE PROVIDER
SUCH AS AN APPLICATION SERVICE PROVIDER**

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Reply Brief (18 pages)

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Docket No. RSW920010035US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Curtis *et al.*

Examiner: Reagan, James A.

Serial No.: 09/810,629

Art Unit: 3621

Filing Date: 03/16/2001

Title: IMPROVED METHOD FOR REPORTING CHARACTERISTICS OF A SERVICE PROVIDER SUCH AS AN APPLICATION SERVICE PROVIDER

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANT

This Reply Brief is in response to the Examiner's Answer, dated February 13, 2006.

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GROUND OF REJECTION 1

Claims 1-42 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gershman and further in view of Brockman et al. (US 2002/0123919).

Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. For example, Gershman in view of Brockman does not teach or suggest the following features of claims 1, 7, 11, 15, 19, 23, and 25:

“generating a report responsive to the outcome; and ... providing the report to at least two clients of the service provider; wherein the acts of analyzing, generating, and providing are performed by a management service”,
wherein the report is responsive to the outcome derived from analyzing the information on the service provider’s:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

The Examiner’s Answer argues that Gershman, Abstract, FIG. 1A, FIG. 16, and col. 34, lines 8-42 discloses the preceding features of claims 1, 7, 11, 15, 19, 23, and 25.

In response to the argument in the Examiner’s Answer, Applicants contend that Gershwin’s Abstract and FIG. 1A (and the description of FIG. 1A in col. 1, line 61 - col. 2, line

13) (which the Examiner's Answer relies on) has no relevance to the preceding features of claims 1, 7, 11, 15, 19, 23, and 25.

Also in response to the argument in the Examiner's Answer, Appellants note that in Gershman's description of FIG. 16 in col. 34, lines 8-42 (which the Examiner's Answer relies on), the "report" is in response to a request by a user for a product report about product X (see Gershman, col. 34, lines 21-23). The report is provided to the user requesting the report, and the report comprises ratings of the product X by users who have previously rated the product X (see Gershman, col. 34, lines 25-26, 38-42). Thus, Appellants respectfully contend that:

A) Gershman, col. 34, lines 8-42 does not disclose that **the report is provided to at least two clients** of the service provider, as required by claims 1, 7, 11, 15, 19, 23, and 25 (i.e., Gershman discloses the only receiver of the report to be the one who requested the report).

B) Gershman, col. 34, lines 8-42 does not disclose that **the report is responsive to the outcome derived from analyzing the information on the service provider's:**

- 1) **characteristics** (claim 1);
- 2) **performance** (claims 7 and 19);
- 3) **security** (claims 11 and 23); and
- 4) **availability** (claims 15 and 27).

Gershman discloses only that the report pertains to rating the product X by users who have previously rated the product. Gershwin does not disclose what aspects of the product X are rated. Gershman does not disclose that any information about the provider of product X is in the report. Indeed, Gershman discloses only that the report includes ratings of the product X, and Gershman does not disclose that the report includes ratings of the provider of product X.

The Examiner's Answer also argues: "Gershman does teach that all types of vendors/suppliers/service providers may be targets for analysis reports (Fig 1A). "

In response, Applicants contend that the Examiner's Answer has made an unsupported allegation, because neither FIG. 1A (which the Examiner's Answer relies on) nor anything else in Gershwin teaches that "all types of vendors/suppliers/service providers may be targets for analysis reports". FIG. 1A may depict various vendors/suppliers/service providers, but does not teach or suggest that any of the various vendors/suppliers/service providers are targets for analysis reports.

With respect to the claimed feature of "the report is provided to at least two clients of the service provider", the Examiner's Answer in "Response to Argument" argues:

"Appellant states *Gershman* does not disclose that the *report is provided* to at least two *clients* of the *service provider*. As shown in the preceding paragraph, Gershman teaches, "The Supplier's Web Server 1070 provides access to all of the supplier's databases necessary to provide information and transactional support to the customer (emphasis added)." Gershman's use of the Internet and networked computing environment innately discloses multiple customers."

In response, Appellants contend that the language of the preceding claimed feature requires that **the same report** be provided to at least two clients of the service provider, because "the report" has antecedent basis in "a report". The Examiner's Answer argues that Gershman discloses providing information and transactional support to multiple customers. However, The Examiner's Answer does not argue that Gershman discloses providing **the same information** and transactional support to multiple customers, as required by claims 1, 7, 11, 15, 19, 23, and 25.

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Moreover, Appellants contend that Gershman does not anywhere teach or suggest providing the same report to at least two clients of the service provider.

With respect to the claimed feature of the report being responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability, the Examiner's Answer in "Response to Argument" argues:

"Appellant states that *Gershman ... does not disclose that the report is responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability.* The Examiner respectfully disagrees and points to Gershman who discloses a report generating function (Figure 16), a database containing information on a product and service providers (ASP's and ISP's), features and descriptions (characteristics), availability and pricing (see column 31, lines 6-20). Gershman also discloses a Thin client hardware application, which clearly illustrates what functions are considered relevant and vital to a network providers functionality i.e. security, performance, and availability. See column 57, lines 12-55. By incorporating these elements into Gershman's own system, Gershman testifies to **the inherent necessity** of reporting these elements to customers of an Internet/Application Service Provider. Brookman, *crstwhile*, discloses that "performance" is yet another yardstick by which clients should measure their intended or current vendors (Par. 17, 6667, 106-109). Other significant characteristics such as price, customer service, and others may be used in the analyses and reports, as taught by both references. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included "performance", "availability", and "security" the main characteristics to analyze and report on, in the case of ASPs and ISPS, because those are by far the most important features distinguishing one vendor from another in this field." (emphasis added).

In response, Appellants contend that Gershman does not **inherently teach** "reporting these elements to customers of an Internet/Application Service Provider". Under case law, the alleged inherency must **necessarily and inevitably** follow from the teachings in the prior art and

a high probability of occurrence is not sufficient demonstrating inherency. See *The Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320 (Fed. Cir. 2004) (holding that “the district court did not address a critical question for inherent anticipation: whether ... practicing the ‘516 patent necessarily featured or resulted in limitation (c) of the ‘168 patent.”). Appellants contend that the inherency alleged by the Examiner’s Answer does not **necessarily and inevitably** follow from the teachings in Gershman.

Moreover, inherency cannot be used to reject a claim under 35 U.S.C. § 103(a) unless the inherency is known to a person of ordinary skill in the art. *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) (reversing the Board’s rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: “[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown”).

In addition, the Examiner’s Answer has not identified an “**outcome**” subject to the limitations of: (1) the report being responsive to said “outcome”; and (2) said “outcome” being derived from analyzing the information on the service provider’s characteristics, performance, security, and availability.” In fact, the Examiner’s Answer has not even alleged a teaching or suggestion of such “outcome” (subject to said recited limitations) in Gershman. By failing to allege and support disclosure of said “outcome” (subject to said recited limitations) in Gershman, the Examiner’s Answer has failed to establish a *prima facie* case of obviousness in relation to claims 1, 7, 11, 15, 19, 23, and 25.

In addition, Gershman does not disclose the following feature of claims 1, 7, 11, 15, 19, 23, and 25: **gathering information** about a service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

Appellants assert that there is no disclosure anywhere in Gershman relating to gathering information about a service provider's characteristics, performance, security, or availability.

The Examiner's Answer argues that Gershman discloses the preceding feature of claims 1, 7, 11, 15, 19, 23, and 25 in Gershman's abstract; FIGS 1A and 1B, and col. 34, lines 8-42.

In response to the argument in the Examiner's Answer, Applicants contend that Gershwin's Abstract and FIG. 1A (and the description of FIG. 1A in col. 1, line 61 - col. 2, line 13) (which the Examiner's Answer relies on) has no relevance to the preceding features of claims 1, 7, 11, 15, 19, 23, and 25.

Also in response to the argument in the Examiner's Answer, Appellants maintain that that in Gershman's description of FIG. 16 in col. 34, lines 8-42 (which the Examiner's Answer relies on), there is no disclosure of gathering information about a service provider's characteristics, performance, security, or availability. Appellants note that Gershman, col. 34, lines 8-42, discloses an algorithm for determining the personalized product ratings of a user, which is unrelated to the preceding first feature of claims 1, 7, 11, 15, 19, 23, and 25. The Examiner's Answer has been unable to cite specific language in Gershman that allegedly discloses information about a service provider's characteristics, performance, security, or availability.

In "Response to Argument", the Examiner's Answer argues:

"Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. Specifically, Appellant states *Gershman ... does not disclose gathering information* about a *service provider's* characteristics, *performance, security, and availability*. The Examiner disagrees and points to the paragraphs above. The combination of Gershman/Brockman discloses a report responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability, and therefore **inherently discloses** the gathering of facts in support of these metrics." (emphasis added).

In response, Appellants contend that Gershman does not **inherently teach** "the gathering of facts in support of these metrics". Under case law, the alleged inherency must **necessarily and inevitably** follow from the teachings in the prior art and a high probability of occurrence is not sufficient demonstrating inherency. See *The Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320 (Fed. Cir. 2004) (holding that "the district court did not address a critical question for inherent anticipation: whether ... practicing the '516 patent necessarily featured or resulted in limitation (c) of the '168 patent."). Appellants contend that the inherency alleged by the Examiner's Answer does not **necessarily and inevitably** follow from the teachings in Gershman.

Moreover, inherency cannot be used to reject a claim under 35 U.S.C. § 103(a). *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown").

In addition, Gershman does not disclose the following feature of claims 1, 7, 11, 15, 19, 23, and 25: **analyzing**, to provide an outcome, the information on the service provider's:

- 1) characteristics (claim 1);
- 2) performance (claims 7 and 19);
- 3) security (claims 11 and 23); and
- 4) availability (claims 15 and 27).

Appellants note that the Examiner's Answer has not provided a citation in Gershman that allegedly teaches or suggests the preceding feature of claims 1, 7, 11, 15, 19, 23, and 25.

In "Response to Arguments", the Examiner's Answer states:

"Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. Specifically, Appellant states *Gershman ... does not disclose analyzing, to provide an outcome, about a service provider's characteristics, performance, security, and availability.* The Examiner disagrees and points to the paragraphs above. The combination of Gershman/Brockman discloses a report responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability, and therefore **inherently discloses** the producing an end result or summary in support of these metrics."

In response, Appellants contend that Gershman does not **inherently teach** "the producing an end result or summary in support of these metrics". Under case law, the alleged inherency must **necessarily and inevitably** follow from the teachings in the prior art and a high probability of occurrence is not sufficient demonstrating inherency. See *The Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320 (Fed. Cir. 2004) (holding that "the district court did not address a critical

question for inherent anticipation: whether ... practicing the '516 patent necessarily featured or resulted in limitation (c) of the '168 patent."). Appellants contend that the inherency alleged by the Examiner's Answer does not necessarily and inevitably follow from the teachings in Gershman.

Moreover, inherency cannot be used to reject a claim under 35 U.S.C. § 103(a) unless the inherency is known to a person of ordinary skill in the art. *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown").

Based on the preceding arguments, Appellants respectfully maintain that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, and that claims 1, 7, 11, 15, 19, 23, and 25 are in condition for allowance.

Since claims 2-6 depend from claim 1, Appellants contend that claims 2-6 are likewise in condition for allowance.

In addition, the Examiner's Answer admits that Gershman in view of Brockman does not disclose the features specific to claims 31-42. See Examiner's Answer, page 5, lines 6-26.

The Examiner's Answer argues that the features specific to claims 31-42

"are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The information collection and storage steps would be performed the same regardless of the data. Thus, this descriptive material will

not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).... Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a service provider any type of security information, performance information, and statistical analysis thereof, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention."

In response, Appellants contend that the argument in the Examiner's Answer is without foundation, because the features specific to claims 31-42 most certainly recite concrete limitations on the performance of method steps.

Claim 31 recites the limitation: "wherein the information on performance of the application service provider includes information about responsiveness of the application service provider". Thus claim 31 further limits the method step in claim 7 of "gathering information on performance of an application service provider" to be subject to the constraint of gathering information on performance specifically pertaining to responsiveness of the application service provider, which is most certainly a further limitation on performance of the "gathering information" step of claim 7.

Claim 32 further limits the method step in claim 31 to be subject to the constraint of gathering information specifically pertaining to responsiveness of the application service provider, such that "the information about responsiveness of the application service provider is characterized statistically by a mean value and a probability density function or cumulative distribution function that describe a time between receipt by the application service provider of

an incoming request to the application service provider and an outgoing response from the application service provider”, which is most certainly a further limitation on performance of the method step of claim 31 and of claim 7.

Claim 33 recites the limitation: “wherein the information on security concerns a vulnerability of the service provider to attacks by unauthorized parties seeking to steal information from the service provider or to vandalize the service provider”. Thus claim 33 further limits the method step in claim 11 of “gathering information on security of an application service provider” to be subject to the constraint of gathering information on security specifically pertaining to “vulnerability of the service provider to attacks by unauthorized parties seeking to steal information from the service provider or to vandalize the service provider”, which is most certainly a further limitation on performance of the “gathering information” step of claim 11.

Claim 34 further limits the method step in claim 33 to be subject to the constraint of gathering information specifically pertaining to security with respect to vulnerability of the service provider to attacks, such that “the information on security is characterized statistically by a count or other measure of said attacks that result in adverse consequences to the service provider or in adverse consequences to one or more clients or in adverse consequences to a member of a user population over a given period of time”, which is most certainly a further limitation on performance of the method step of claim 33 and of claim 11.

Claim 35 recites the limitation: “wherein the information on availability of the application service provider concerns a susceptibility of the service provider to failure”. Thus claim 35 further limits the method step in claim 15 of “gathering information on availability of an application service provider” to be subject to the constraint of gathering information on

availability specifically pertaining to "a susceptibility of the service provider to failure", which is most certainly a further limitation on performance of the "gathering information" step of claim 15.

Claim 36 further limits the method step in claim 35 to be subject to the constraint of gathering information specifically pertaining to availability with respect to a susceptibility of the service provider to failure, such that "said failure is measured by minutes-of-time-per-month when the service provider is unable to respond within a predetermined interval to an incoming request from a client or from a member of a user population", which is most certainly a further limitation on performance of the method step of claim 35 and of claim 15.

Claims 37-42 are similar to claims 31-36, respectively, except that the service provider is an application service provider in claims 31-36 whereas the service provider is an Internet service provider in claims 37-42.

Therefore, since the Examiner's Answer has admitted that Gershman in view of Brockman does not disclose the features specific to claims 31-42, Appellants respectfully maintain that claims 31-42 are not unpatentable over Gershman in view of Brockman.

As to combining the references of Gershman and Brockman to reject the claims under appeal, the Examiner argues:

"In the instant case, Gershman discloses generating product information and providing access to rating and reports of products and services carried out by a computer networked system i.e. the Internet. Brockman discloses aggregation and analysis of customer oriented telecommunications data i.e. ASP's and ISP's and providing that data to interested parties. Gershman states, "The present invention relates to agent based systems and more particularly to a mobile computing

environment that accesses the Internet to obtain product information for a user utilizing a distributed communication network." Brockman discloses determining whether or not business resources are being properly utilized (see at least paragraph 004). ASPs and ISPs are vendors playing major roles in business applications and telecommunications. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have adapted Gershman's system to many different types of providers, including telecommunications vendors such as ISP's, as taught by Brockman, and/or to ASP's, because the system can easily be adapted to any type of provider, and as such, would increase the revenue stream for the management service. As such, it is seen that the Examiner's combination of references is supported by the applied prior art of record. Ergo it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93)."

In response, Appellants contend that the Examiner's Answer has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Gershman by the alleged teaching of Brockman in relation to the claims under appeal. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have

made the motivation obvious **unless the prior art suggested the desirability of the modification.**”). The Examiner’s Answer has not made any showing of where the prior art suggests the motivation to combine Brockman with Gershman alleged by the Examiner’s Answer. Thus, the Examiner’s Answer has provided an alleged motivation for the combination by speculation, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for modifying Gershman by the alleged teaching of Brockman in relation to the claims under appeal, the Examiner has failed to establish a *prima facie* case of obviousness in relation to the claims under appeal.

As to whether the Examiner’s Answer is legally obligated to cite prior art to support motivation to combine the references, the Examiner’s Answer argues:

“With regard to any suggestion that there is no motivation to combine the applied references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).”

In response, Appellants contend that the cases of *In re Fine* and *In re Jones*, cited by the Examiner, support Appellants arguments and do not support the Examiner’s arguments. In both *In re Fine* and *In re Jones*, the Federal Circuit reversed claim rejections based on hindsight reasoning and lack of evidence to support the Examiner’s contention that one of ordinary skill in the art would have been motivated to modify the pertinent prior art reference(s).

In *In re Fine*, the Federal Court reasoned:

"Fine says the PTO has not established a *prima facie* case of obviousness. He contends the references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art. He argues that the appealed claims were rejected because the PTO thought it would have been "obvious to try" the claimed invention, an unacceptable basis for rejection.... We agree. The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed.Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lali*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed.Cir. 1984); see also *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 n. 24, 227 USPQ 657, 667 n. 24 (Fed.Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention.

Fine, 5 USPQ2d at 1598 .

In *In re Jones*, the Federal Court reasoned:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed.Cir. 1988). We see no such suggestion in *Zorayan*, which is directed to shampoo additives, nor in *Wideman*, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the broad disclosure of Richter fill the gap, for the reasons discussed above.... [25] Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of

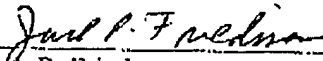
the prior art salts necessary to arrive at the claimed 2-(2'-aminooethoxy) ethanol salt. *See Grabiak*, 769 F.2d at 731-32, 226 USPQ at 872 ("[I]n the case before us there must be adequate support in the prior art for the [prior art] ester/[claimed] thioester change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant."); *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed.Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.")
Jones, 21 USPQ2d at 1943-4.

In conclusion, both the cases of *In re Fine* and *In re Jones*, cited by the Examiner, support Appellants arguments that the Examiner has not persuasively supported the Examiner's arguments with evidence to modify and/or combine references to reject claims under appeal.

SUMMARY

In summary, Appellant respectfully requests reversal of the March 10, 2005 Office Action rejection of claims 1-42.

Respectfully submitted,



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Dated: 04/11/2006

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